

REMARKS

I. The §112 Rejection of Claim 3

Claim 3 was rejected under 35 U.S.C. §112, second paragraph. The Examiner contends that it is unclear what the phrase “in the control channel” (line 6) is referring to. Applicants respectfully disagree and traverse this rejection.

Notwithstanding the fact that the Applicants believe this phrase is quite clear, to expedite examination, the Applicants have amended Claim 3. In light of the amendment to claim 3 the Applicants respectfully request withdrawal of the rejection and allowance of claim 3.

II. The Section 103 Rejection of Claims 1, 3-9 and 13-14

Claims 1, 3-9 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over prior art disclosed in the instant application combined with European Patent Application No. EP 1-067-730 A1 to Mortensen (“Mortensen”). The Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Of the rejected claims, claims 1, 13 and 14 are independent. It is to these claims that Applicants direct their remarks, it being understood that the remarks apply to dependent claims 3-9 as well.

Independent claims 1, 13 and 14 include the feature of separately decoding a portion of coded information before a remainder of the coded information is decoded, and deriving transmission format information from the

separately decoded portion of the encoded signaling information for the corresponding data transmission before a remainder of the encoded signaling information is decoded. The Examiner acknowledges that the disclosed prior art does not disclose this feature. However, the Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the teaching of the disclosed prior art using the teaching of Mortensen. Applicants disagree, for at least the following reasons.

Mortensen appears to disclose an improved method of determining the transmission quality of a radio channel in a UMTS environment by dividing the signaling data within a Dedicated Physical Control Channel (“DPCCH”) into two parts (see Mortensen, ¶¶ [0005] and ¶[0007]). The first part is encoded with a higher redundancy than a second part. In the receiver, the (decoded) first part is then compared to reference code blocks to generate an on-going estimate of channel impairment, i.e., a bit-error-rate (BER). *Id.* at ¶[0007]. It appears from the Office Action that the Examiner is taking the position that Mortensen’s partitioning of its DPCCH signaling data and use of one of the partitions for BER rate calculations as well as for “parameters of the decoding scheme” (¶[0014]) is akin to the claimed features of separately decoding a portion of encoded signaling information, deriving transmission format information therefrom, and doing so before a remainder of the coded information is decoded. However, Mortensen does not appear to describe the decoding of its DPCCH signaling data – either the first or second part -- as

being completed *before* a remainder of encoded signaling information is decoded as in Applicants' claimed invention. Rather, Mortensen's signaling information appears to be decoded in an ordinary UMTS fashion by a receiver "having the architecture of the well-known RAKE receiver...additionally equipped with a circuit C for determining the transmission quality of the radio channel...." (see Mortensen, ¶¶[0033]-[0034] and Figs 3 and 4).

Further, even if it somehow it can be argued that Mortensen derives transmission format information from DPCCH signaling data, the derivation simply isn't done before a remainder of the encoded signaling information is decoded as in Applicants' claimed invention.

Still further, combining Mortensen with the disclosed prior art would require either one of these references to change their principle of operation, which the Examiner knows is impermissible.

For example, in Mortensen signaling data is transmitted within a time frame TF, described at ¶[0019]. Several TFs, having a combined duration of *20 seconds*, are employed in order to generate "a more reliable" BER which can be compared to a minimum threshold (see Fig. 1 and ¶[0025]). In comparison, the disclosed prior art uses an exemplary time period or timeframe of 2 milliseconds (see Fig. 2 of the instant specification). Accordingly, combining Mortensen with the disclosed prior art would either require Mortensen and/or the disclosed prior art to change their respective time periods and thus their

principle(s) of operation. Under such circumstances, as the Examiner knows well, the proposed combination is impermissible.

For at least these reasons, the subject matter of Claims 1, 13 and 14 (and dependent claims 3-9) would not have been obvious to one of ordinary skill in the art at the time the present application was filed based on the combination of prior art disclosed in the instant specification and the disclosures in Mortensen. Applicants respectfully request withdrawal of the rejections and allowance of claims 1, 3-9 and 13-14.

II. The Section 103 Rejection of Claims 10-12

Claims 10-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of prior art disclosed in the instant specification, Mortensen, and U.S. Patent No. 6,311,306 to White ("White"). The Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Regarding claims 10 and 11, because these claims are dependent on claim 1 they include all of the features of claim 1. Accordingly, claims 10 and 11 are patentable over the cited references for the reasons set forth above and because White does not overcome the deficiencies of the disclosed prior art and Mortensen.

Regarding independent claim 12, because it now includes similar features as claim 1 it too is patentable over the cited references for the reasons

set forth above and because White does not overcome the deficiencies of the disclosed prior art and Mortensen.

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Should there be any outstanding matters that need to be resolved in the present application the Examiner is respectfully requested to contact John E. Curtin at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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